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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,246	09/12/2006	Mark L. Lawrence	028186.61646	5820

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EXAMINER

NAVARRO, ALBERT MARK

ART UNIT	PAPER NUMBER
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1645

MAIL DATE	DELIVERY MODE
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09/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,246	Applicant(s) LAWRENCE ET AL.	
	Examiner Mark Navarro	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 26-30,33,46-49,52-56,59-62,65-68,71-76 and 79-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9-12,21-25,35-38 and 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-5,9-12,21-30,33,35-38,41-43,46-49,52-56,59-62,65-68,71-76 and 79-83.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 3, 2010 has been entered.

Claims 6-8, 13-20, 31-32, 34, 39-40, 44-45, 50-51, 57-58, 63-64, 69-70, 77-78, and 84-85 have been cancelled. Consequently, claims 1-5, 9-12, 21-30, 33, 35-38, 41-43, 46-49, 52-56, 59-62, 65-68, 71-76, and 79-83 are pending in the instant application, of which claims 26-30, 33, 46-49, 52-56, 59-62, 65-68, 71-76, and 79-83 have been withdrawn from further consideration as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

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except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. The rejection of claims 1-5, 9-12, 21-25, 35-38, and 41-43 under 35 U.S.C. 102(a & e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mahan et al in view of May et al is withdrawn in view of the abandonment of US Publication 2002/0068068.

The following new grounds of rejection are applied to the claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 9-12, 21-25, 35-38 and 41-43 are rejected under 35 U.S.C. 102(e) as being as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mahan et al.

The claims are directed to an attenuated strain of a bacteria of the species *Pasteurella multocida*, said bacteria comprising altered DNA adenine methylase (Dam) activity such that the bacteria are attenuated.

Mahan et al (US Patent Number 7,026,155) disclose of compositions containing *Pasteurella multocida* bacteria having non-reverting genetic mutations which alter activity of DNA adenine methylase (Dam) resulting in attenuation. (See claim 9 and detailed paragraph 29).

NOTE: This rejection is virtually identical to the earlier stated rejection, however the US Publication (since abandoned) has been replaced with US Patent 7,026,155. Both applications are by the same inventor and have the same filing dates.

Applicants have filed a Declaration under 37 CFR 1.131 to show conception coupled with diligence prior to US Publication 2002/0068068 (analogous filing date to US Patent 7,026,155).

Applicants Declaration under 37 CFR 1.131 to show conception coupled with diligence prior to US Publication 2002/0068068 (corresponding equivalent US Patent 7,026,155) remains ineffective for reasons of record. Ordinarily an applicant may use an affidavit of prior invention under 37 CFR 1.131 to overcome a rejection under 35 U.S.C. 102 (a) or 102 (e). An **exception to the rule** arises when the reference is a patent or application published under 35 U.S.C. 122 (b) and the reference has **claims directed to the same patentable invention as the application claims being rejected. 37 CFR 1.131**. The reason for this exception is that priority is determined in an interference when the claims interfere. 35 U.S.C. 135 (a). **In such a case, the**

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applicant must make the priority showing under 37 CFR 41.202 (d) instead. (See MPEP 2305) (Emphasis added). Since, US Patent Number 7,026,155 has claims directed to a non-pathogenic strain of *Pasteurella multocida* having an altered DNA adenine methylase activity; structurally identical to the attenuated strain of *Pasteurella multocida* having altered DNA adenine methylase activity such that the bacteria are attenuated of the instantly filed claim 1; Applicants Declaration under 37 CFR 1.131 is insufficient to overcome the rejection of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro whose telephone number is (571) 272-0861.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Navarro/
Primary Examiner, Art Unit 1645
September 21, 2010